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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,095	03/31/2000	Richard Thomas Box	AND1P051F	2254

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OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE)  
PLAZA VII, SUITE 3300  
45 SOUTH SEVENTH STREET  
MINNEAPOLIS, MN 55402-1609

EXAMINER
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POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/540,095

Applicant(s)

BOX, RICHARD THOMAS

Examiner

Robert M. Pond

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Nly

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 18, 20.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended Claim 40 to overcome a 35 USC 112 rejection, amended all claims to overcome numbering objections, and newly added Claim 70. All pending claims (40-70) were examined in this non-final Office Action.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 09 January 2004, with respect to the rejection(s) of claim(s) 40-69 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chelliah and Fleming. Chelliah teaches a method of conducting electronic commerce between a plurality of customers and one or more service providers via an electronic mall. The mall provides a central user interface that connects the customer to one or more service providers that participate in the electronic mall. The electronic mall monitors and logs customer transactions, creates customer profiles based on demographics and purchasing habits, targets services based on the customer's demographics and purchasing habits, receives transaction information from the customer based on customer selections of information. Fleming teaches online service providers who are government agencies, filing electronic documents over the Internet formatted to meet the

needs of the government agencies requiring the filings, and further teaches routing filed forms to other agencies based on the one-time filing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 40-50, 52, 53, 56-61, 63-65 and 68-70 are rejected under 35 USC 103(a) as being unpatentable over Chelliah et al. (patent number 5,710,887, hereinafter referred to as "Chelliah"), in view of Fleming (PTO-892, Item: U).**

Chelliah teaches a system and method of an electronic mall that facilitates commercial transactions between a plurality of system users (referred to as customers by Chelliah) and at least one provider of goods and services (please see at least abstract; col. 1, lines 20-22; col. 6, lines 4-57; col. 14, lines 47-48).

Chelliah further teaches:

- Registering a system user, creating a system user profile: (see at least col. 7, lines 17-19; col. 10, lines 18-25; col. 26, lines 15-19).
- Receiving identification information from the system user: participant program object; use of passwords to secure user information (see at least

Fig. 9 (216); col. 9, lines 30-38; col. 9, line 62 through col. 10, line 2; col. 10, lines 28-30; col. 9, lines 49-51).

- Providing secure access to services: Security Subsystem; secure and reliable order and financial transaction processing; RSA public key encryption technology (see at least col. 6, lines 58-65; col. 7, line 15; col. 9, lines 8-19).
- Services limited based on the user profile: narrowcasts targeted services to user based on user's demographics or purchasing habits as defined by participant subsystem and customer accounts subsystem (see at least col. 12, lines 34-42).
- Managing transaction information from the user, conform to standards: compliance with CORBA; meeting the needs and responsibilities of the entities involved; validates user selection; validates payment to provider (see at least col. 2, lines 36-43; col. 9, lines 44-48; col. 13, lines 10-19; col. 14, lines 56-58; col. 16, lines 21-31).
- Tracking user interactions: tracks user interactions for historical or real-time analysis (see at least col. 7, lines 40-45; col. 25, lines 65-67).
- Performing billing functions: receiving electronic payment from user (see at least col. 15, lines 43-49; col. 16, lines 3-20).
- Graphical user interface: communicates with plurality of providers; selects provider; selects products or services (see at least col. 6, lines 31-43; col. 7, lines 46-48; col. 12, lines 43-44).

- Meeting provider requirements: a quantity requirement (see at least col. 18, lines 46-48); meeting a minimum requirement (see at least col. 21, lines 45-47).
- Confirming receipt: confirms; generates receipt (see at least col. 4, lines 27-29; col. 17, lines 31-35).
- Determining tax information: tax engine calculates tax (see at least col. 11, lines 19-24).
- Determining modes of communication: computer, telephone, interactive TV, set-top box, touch sensitive screen (please note examiner's interpretation: system determines mode of communication based on meeting needs of provider) (see at least col. 6, lines 31-34).
- Format and data structure: HTML; object structure, CORBA (see at least col. 14, lines 31-39).
- Certificate: computes an encrypted payment authorization token based upon the password entered by the user (see at least col. 16, lines 16-20).
- Customer customized user interface: displays information based on customer's demographics or purchasing habits (see at least col. 9, line 64 through col. 10, line 2; col. 12, lines 34-42).
- Filing a report

Chelliah teaches all the above as noted under the 103(a) rejection and teaches a) an electronic commerce system and method that manages the interaction between a plurality of users with one or more service providers

via an electronic mail desiring to conduct business with one or more service providers, b) transforming a manual activity with a service provider into an electronic commerce medium activity, c) submitting an electronic communications using HTML formatted documents (e.g. akin to a shopping basket) with a provider of products or services resulting in an electronic transaction, and d) interacting with a plurality of providers through a common user-to-system interface using HTML documents, but does not disclose filing a report with a government entity. Fleming teaches replacing manual activity by conducting business with government departments over the Internet. Fleming teaches citizen-to-government online interaction and business-to-government online interaction, the adoption of electronic forms used to transfer the collection and processing of information from a physical world to and electronic world, providing automatic validation of data using encrypted electronic signature, converting a paper form into an electronic form, filing taxes, and filing a notification of self-employment once electronically and automatically routing the form to three different government departments (U: see at least pages 1- 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Chelliah to include submitting an electronic form with any number of service providers as taught by Fleming, in order to conduct electronic form filing activities with a service provider providing government services.

- 2. Claim 51 is rejected under 35 USC 103(a) as being unpatentable over Chelliah (patent number 5,710,887) and Fleming (PTO-892, Item: U), as applied to Claim 46, further in view of Vanechanos, Jr. (patent number 5,884,309).**

Chelliah and Fleming teach all the above as noted under the 103(a) rejection and teach accessing service providers through an electronic mall, filing forms, and making selection from an electronic catalog, but do not disclose a search engine. Vanechanos, Jr. teaches conducting electronic commerce through electronic malls, processing electronic forms submitted by remote users, and further teaches the use of a search engine to facilitate electronic commerce (see at least abstract; col. 2, lines 46-63). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Chelliah and Fleming to implement a search engine to facilitate electronic commerce, and thereby attract users to the service.

- 3. Claims 54-55 and 62 are rejected under 35 USC 103(a) as being unpatentable over Chelliah (patent number 5,710,887) and Fleming (PTO-892, Item: U), as applied to Claim 40, further in view of Proctor (Paper # 15, PTO-892, Item: W).**

Chelliah and Fleming teach all the above as noted under the 103(a) rejection and teach implementing security features (e.g. encrypted tokens for authorization) and logging a user's transactions associated with an electronic



mall storefront, but do not disclose the monitoring and detection of abusive patterns of use. Proctor teaches the state of the art of intrusion detection systems covering the following topics, but not limited to: monitoring networks and systems for abnormal behavior, and use of audit data to detect patterns of abuse, trending analysis, and audit log reduction and archiving (Paper #15, Item: W, see pages 1-7). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chelliah and Fleming to include intrusion detection system features as taught by Proctor, in order to improve overall system security and performance, and encourage users to use the online service.

- 4. Claims 66-67 are rejected under 35 USC 103(a) as being unpatentable over Chelliah (patent number 5,710,887) and Fleming (PTO-892, Item: U), as applied to Claim 64.**

Chelliah and Fleming teach all the above as noted under the 103(a) rejection and teach filing reports electronically over the Internet with service providers providing government services connected to an online service mall (e.g. Inland Revenue, Customs and Excise, and the Contributions Agency), and further teach report filings typical for citizens or entities to file to meet government requirements, but do not disclose other government agencies. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose

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any number of government agencies, since it is well within the skill to ascertain that any number of government agencies can participate in online report filing.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

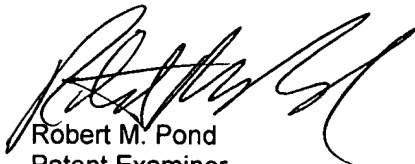
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***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Robert M. Pond  
Patent Examiner  
April 28, 2004